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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/231,565	04/22/94	KAWAKAMI Y	20264124

HM21/0605

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EXAMINER	
HUFF, S	
ART UNIT	**PAPER NUMBER**
1642	25

DATE MAILED: 06/05/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/231,565	Kawakami et al
Examiner	**Group Art Unit**
Sheela J. Huff	1642

☒ Responsive to communication(s) filed on *Dec 16, 1997* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *56-60 and 62-65* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *56-60 and 62-65* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1.The Group/Art Unit handling this application has changed. Please direct all future communications to Technology Center 1600, Art Unit 1642.

Continued Prosecution Application

2. The request filed on 12/16/97 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/231565 is acceptable and a CPA has been established. An action on the CPA follows.

3. The amendments filed on 9/19/97 and 12/16/97 have been entered.

Claims 1-55 and 61 are cancelled.

Claims 56-61 and 62-65 are pending.

4. The rejections under 35 U.S.C. 112, first paragraph, and 35 U.S.C. 112, second paragraph are withdrawn in view of applicant's amendments.

Response to Arguments

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 56-57 remain rejected under 35 U.S.C. 102(a) as being anticipated by Adema et al Am. J. Pathol. vol. 143 1579 (12/93). The reasons for this rejection are record in paper no. 13, mailed 9/19/95.

Applicant's arguments have been addressed in paper no. 18, mailed 9/23/97. No new arguments have been presented.

7. Claim 56 remains rejected under 35 U.S.C. 102(b) as being anticipated by Kwon et al PNAS vol. 88 p. 9228 (1991). The reasons for this rejection are record in paper no. 13, mailed 9/19/95.

Applicant's arguments have been addressed in paper no. 18, mailed 9/23/97. No new arguments have been presented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 56-57 remain rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/21767 in view of by Kwon et al PNAS vol. 88 p. 9228 (1991).

Applicant's arguments have been addressed in paper no. 18, mailed 9/23/97. No new arguments have been presented.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

11. Claims 58-60 and 63-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 58, last line "(c)" should be --(b)--.

b. In claim 63, the terminology "substantially homologous" renders the claim vague and indefinite. As seen by Reeck et al Cell vol. 50 p. 667 (1987) and Lewin, Science

vol. 237 p. 1570 (1987) the rampant use of the terminology "homology" is clogging the literature with muddy writing and thinking (first and second paragraphs). These references go on to clearly show that the terminology "homology" is vague and indefinite.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. Claims 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated Kwon US 5679511.

This reference discloses and claims the nucleic acid sequence of p-mel, which is also known as gp100) and said sequence in expression vectors (see entire reference).

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 56, 58-60 and 62-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 62 of copending Application No. 09/007961. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims read on the nucleic acid sequence of MART-1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

16. No Claim is allowed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703) 305-7866. The Examiner can normally be reached on Monday-Thursday from 6:30am to 3:00pm.

If attempts to teach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lila Feisee, can be reached on (703)308-2731.

The FAX phone number for the group is (703)308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[lila.feisee@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0196.

Sheela J. Huff
May 27, 1998

Sheela J. Huff
Primary Examiner